

DEC 17 1990

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No. 89-1909

**In The
Supreme Court
of the
United States**

October Term, 1990

FEIST PUBLICATIONS, INC.,
Petitioner,

v.

RURAL TELEPHONE SERVICE COMPANY, INC.
Respondent.

**ON WRIT OF CERTIORARI TO THE UNITED STATES
COURT OF APPEALS FOR THE TENTH CIRCUIT**

**BRIEF OF BELL SOUTH CORPORATION AS
AMICUS CURIAE IN SUPPORT OF RESPONDENT
RURAL TELEPHONE SERVICE COMPANY, INC.**

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BRIEF OF BELL SOUTH CORPORATION AS
 AMICUS CURIAE IN SUPPORT OF RESPONDENT
 RURAL TELEPHONE SERVICE COMPANY, INC.

THE INTEREST OF AMICUS CURIAE¹

BellSouth Corporation ("BellSouth") is a holding company for two former Bell System operating telephone companies; namely, Southern Bell Telephone and Telegraph Company ("Southern Bell") and South Central Bell Telephone Company ("South Central Bell"). Upon the divestiture of AT&T, BellSouth created BellSouth Advertising & Publishing Corporation ("BAPCO") as a subsidiary for the purpose of creating, compiling, publish-

¹ The written consent of Petitioner and Respondent to the filing of this brief is being filed contemporaneously herewith with the Clerk of the Court.

ing and distributing, among other things, telephone directories. Pursuant to exclusive license agreements between BAPCO and Southern Bell and between BAPCO and South Central Bell, BAPCO is engaged in the business of creating, compiling, publishing and distributing telephone directories, i.e., directories including white pages portions and/or yellow pages portions, in the states of Georgia, Florida, Tennessee, North Carolina, South Carolina, Alabama, Louisiana, Mississippi and Kentucky.² Annually, BAPCO publishes approximately 500 directories for Southern Bell and South Central Bell in these nine states for approximately 18 million subscribers.

Since 1985, BAPCO has been engaged in litigation involving the infringement by various companies of BAPCO's copyrights in its telephone directories. In October 1985, BAPCO brought suit against Donnelley Information Publishing, Inc. ("Donnelley")³ for infringement of BAPCO's copyrights in the yellow pages portions of BAPCO's directories published in Miami and other cities in Florida.

After completing discovery, BAPCO and Donnelley both moved for summary judgment on the issue of copyright infringement. In a thorough and well reasoned opinion, the court found that Donnelley had infringed BAPCO's copyrights. The court noted an apparent difference in reasoning among various courts on the issue of copyrightability of directories, but found it unnecessary

² Southern Bell and South Central Bell license third parties to use their listing information for publication in competing telephone directories.

³ Donnelley is a subsidiary of The Dun & Bradstreet Corporation and a sister company of Donnelley Marketing, Inc., one of the amici in the present case in support of the Petitioner.

to resolve that difference because BAPCO's directories met all of the standards applied by the courts:

Some courts have applied a "sweat of the brow" test to determine whether a particular compilation is copyrightable. . . . Other courts apply a "selection, coordination or arrangement" test in assessing copyrightability. Although the Court prefers the "selection, coordination or arrangement" test, it is not clear which test the Eleventh Circuit adopted in *Assoc. Tel. Directory [Southern Bell Tel. & Tel. Co. v. Associated Tel. Directory Publishers]*, 756 F.2d 801 (11th Cir. 1985). It is clear, however, that BAPCO's directory meets both tests.

BellSouth Advertising & Publishing Corp. v. Donnelley Information Publishing, Inc., 719 F. Supp. 1551, 1557 (S.D. Fla. 1988), *appeal docketed*, No. 89-5131 (11th Cir. February 6, 1989) (emphasis added) (footnotes omitted). In addition to finding that BAPCO had expended great time, effort and expense in compiling its directories, the court found that BAPCO's directories were the result of numerous acts of collection, assembly, selection, coordination and arrangement all of which was copied by Donnelley, *id.* at 1557-58 ("These acts include selection of the geographical area to be covered by a directory; . . . and selection of the date of closing the directory.") (citation omitted).

The court found Donnelley's copying constituted three separate acts of copyright infringement. "[T]he Court gleans from the record, three acts of copying. These include keying the information into the computer, preparing the sales lead sheets and publishing the Donnelley directories." *Id.* at 1559.

Donnelley appealed the decision of the district court to the United States Court of Appeals for the Eleventh Circuit. Donnelley alleged as an error by the district court that the material copied by Donnelley was not a substantial copying of copyrightable expression from the BAPCO directories, i.e., the selection, coordination or arrangement of the facts contained in said directories was not copied. The appeal has been briefed and argued and is presently under consideration by the Eleventh Circuit.⁴

On April 20, 1989, Donnelley Marketing, Inc. ("Donnelley Marketing"), a sister company of Donnelley, brought a declaratory judgment action against BAPCO.⁵ Donnelley Marketing is in the business of providing direct marketing services to customers throughout the United States through use of its national consumer database. Donnelley Marketing's database contains the names, addresses and telephone numbers of over 80 million American households. Donnelley Marketing obtains names, addresses and telephone numbers to update its national consumer database by copying white pages telephone directories, including copyrighted white pages telephone directories published by BAPCO. In its complaint, Donnelley Marketing requested the court to declare that BAPCO's white pages telephone directories are not copyrightable subject matter and that the information which Donnelley copied from those directories was not protected by BAPCO's copyrights because the copied

⁴ Donnelley filed a motion with the Eleventh Circuit requesting that the court stay its consideration of the appeal pending this Court's ruling in the present case. The Eleventh Circuit denied Donnelley's motion without comment.

⁵ That lawsuit is styled *Donnelley Marketing, Inc. v. BellSouth Advertising & Publishing Corp.*, United States District Court for the Eastern District of North Carolina, Raleigh Division, Civil Action No. 89-302-CIV-5-BR.

names, addresses and telephone numbers were noncopyrightable facts.

In that lawsuit, BAPCO contends that its white pages telephone directories are indeed copyrightable subject matter because of the tremendous amount of effort, judgment, skill and expense required to collect and assemble material for its directories and because of numerous acts of selection, coordination and arrangement performed in the compilation and publication process. For example, BAPCO's acts of selection include, among others, selection of a geographic scope for each of its telephone directories,⁶ selection of a directory close date⁷ and selection of a multitude of other compilation practices which affect the particular selection of listings eventually published in each directory.

BAPCO has also filed lawsuits against other companies for infringement of BAPCO's copyrights in its directories. Those cases are as follows: *BellSouth Advertising & Publishing Corp. v. American Business Lists, Inc.* and *American Business Information, Inc.*, United States Dis-

⁶ The geographic scope of a directory is the geographic area which the directory covers. Only a small portion of all Southern Bell telephone subscribers appear in any one directory. BAPCO selects which of Southern Bell's millions of telephone service subscribers will appear in a particular directory by determining the appropriate geographic coverage of that directory.

⁷ The telephone subscribers for Southern Bell and South Central Bell are in a state of constant change; telephone service is discontinued, new service is begun and telephone numbers are changed. Approximately one-third of the listings in BAPCO's directories change from one year to the next. The directory close date is the date after which new Southern Bell telephone service subscribers should not appear in a particular directory. BAPCO, however, has certain policies which permit BAPCO to subjectively determine whether a Southern Bell subscriber will appear in a directory even after the directory close date.

trict Court for the Northern District of Georgia, Atlanta Division, Civil Action No. 1:90-CV-149-MHS; and *BellSouth Advertising & Publishing Corporation v. EKI, Inc.*, United States District Court for the Northern District of Georgia, Atlanta Division, Civil Action No. 1:90-CV-971-MHS. No substantive rulings or orders have been issued in either of the foregoing cases.

Although the present case does not bear directly on all of the issues involved in the foregoing cases, the holding of this Court in the present case may have an effect on some of the issues in those cases. At a minimum, however, the ruling by this Court in the present case will affect BAPCO's ability to enforce its copyrights in its directories against future infringers who engage in copying activities similar to those of Petitioner, Feist Publications, Inc. ("Feist").

SUMMARY OF ARGUMENT

A. Prior to the Copyright Act of 1976, courts consistently found compilations of preexisting material, such as telephone directories, to be copyrightable subject matter.

It is contended in the petition for certiorari that an alleged conflict exists among the circuits as to the basis for copyrightability and infringement of white pages telephone directories published by a local telephone company. BellSouth submits that no such conflict exists. Courts in the various circuits have uniformly and consistently found telephone directories published by local telephone companies to be copyrightable and the copying of the compilation of names, addresses and telephone numbers contained therein to be copyright infringement.

Courts, construing the Copyright Act of 1909 (the "1909 Copyright Act"), as well as the Copyright Act of 1976 (the "1976 Copyright Act"), have consistently found directories, including telephone directories, to be copyrightable subject matter. These directories were held to be copyrightable based on different standards, *e.g.*, the investment of labor, skill and judgment, or the arrangement of preexisting material. BellSouth is not aware of a single case decided under either the 1909 Copyright Act or the 1976 Copyright Act in which a telephone directory has been found not to be copyrightable.⁸

B. The legislative history of the Copyright Act of 1976 demonstrates the Congressional intent to include as "original works of authorship," and thereby extend copyright protection to, compilations, such as telephone directories.

The copyrightability of directories, including telephone directories, is controlled by 17 U.S.C. §102 (1976). Section 102(a) provides that copyright protection extends to "original works of authorship" which specifically include "literary works." The legislative history of Section 102 demonstrates that "literary works" were intended to include catalogs, directories, and similar factual, reference, or institutional works and compilations of data, such as computer databases.

In enacting the 1976 Copyright Act, Congress intended that the term "original works of authorship" should have the same meaning as established by prior judicial decisions under the 1909 Copyright Act. Under that Act, directories, including telephone directories,

⁸ *Cf. Black's Guide, Inc. v. Mediamerics Inc.*, 16 U.S.P.Q.2d 1769 (N.D. Cal. 1990) (a recent district court case distinguishable because it does not relate to a telephone directory.)

were consistently found by the courts to be copyrightable subject matter. Those courts found that telephone directories constituted copyrightable subject matter by the application of either the "sweat of the brow" standard of originality or the "arrangement" standard of originality. Accordingly, telephone directories found to be "original works of authorship" under both standards were intended by Congress to be copyrightable subject matter under the 1976 Copyright Act. The definition of a compilation in Section 101 of the 1976 Copyright Act therefore encompasses compilations created by "sweat of the brow" or by "arrangement."

C. The scope of copyright protection for compilations is determined by whether the copyrightable expression was copied.

Section 103 of the 1976 Copyright Act provides that the copyright in a compilation extends only to the material contributed by the author and not to the preexisting material. The copying of a single fact from a copyrighted compilation therefore clearly does not constitute copyright infringement because the copyright does not extend to that lone fact. However, when there has been a substantial copying of the copyrightable expression of those facts, i.e., a substantial copying of the compilation, copyright infringement should be found.

The Copyright Law was enacted to protect against the unauthorized commercial exploitation of a copyrighted work. The progress of science and the useful arts is promoted by protecting the copyrightable expression of a compilation. This basic premise of Copyright Law would be frustrated if a copier were allowed to appropriate for commercial benefit the substance of a compilation.

ARGUMENT

A. Prior to the Copyright Act of 1976, courts consistently found compilations of preexisting material, such as telephone directories, to be copyrightable subject matter.

Petitioner in this case claims that there is a conflict in the circuits as to the appropriate test to apply to copyrightability of compilations, asserting a distinction between courts applying a "sweat of the brow approach" and courts requiring an "arrangement" standard. Upon close examination of these cases, there is in fact no conflict as all courts have recognized that the type of work employed in creating a telephone directory is deserving of protection. These allegedly different tests are simply different articulations relating to the same "originality" inquiry described below.

The history of the unwavering protection of copyrights in directories, including telephone directories, prior to the 1976 Copyright Act is both important and informative.⁹ Since the legislative history of the 1976 Copyright Act makes it clear that the standards for copyrightability established by the courts under the 1909 Copyright Act were to be incorporated without change, a review of the judicial decisions relating to the copyrightability of directories under the 1909 Copyright Act will therefore be informative.

⁹ It is remarkable that Feist avoids a discussion of the long line of telephone directory copyright cases. The implication of that oversight, however, is clear. These cases demonstrate a clear judicial intention to protect telephone directories from those who would exploit them for personal profit.

1. Under the 1909 Copyright Act, directories were found to be copyrightable subject matter.

Prior to the 1976 Copyright Act, directories uniformly enjoyed a long and unbroken series of decisions sustaining copyright protection. One of the earliest and now a landmark decision involving copyright protection for telephone directories was *Leon v. Pacific Tel. & Tel. Co.*, 91 F.2d 484 (9th Cir. 1937). In that case, Pacific Telephone compiled and published a conventional white pages telephone directory including the name and address and corresponding telephone number of subscribers arranged in alphabetical order. The defendant copied the listings from the plaintiff's telephone directory and rearranged them into telephone number order. That is, the defendant's directory included the same collection or selection of listings copied from the plaintiff's directory but they were arranged in numerical order based on telephone number.¹⁰

In concluding that Pacific Bell's directory was entitled to copyright protection, the court noted:

That a directory may be copyrighted is well settled. The principle is recognized in the statute (Act of March 4, 1909, ch. 320, §5, 35 Stat. 1076): 17 U.S.C.A. §5). . . .

Leon, 91 F.2d at 486.

The court also determined that the telephone directory was copyrightable subject matter based on the effort or labor expended by the author in preparing the compilation. This basis for finding compilations to be original works of authorship, and therefore, copyrightable subject

¹⁰ Such directories are often referred to as inverted or criss-cross directories.

matter, is sometimes termed "sweat of the brow."¹¹ In explaining the "sweat of the brow" standard of originality, the *Leon* court relied upon *Jeweler's Circular Publishing Co. v. Keystone Publishing Co.*, 281 F. 83 (2d Cir.), cert. denied, 259 U.S. 581 (1922).

Prior to the 1976 Copyright Act, the copyrightability of directories based on the investment of labor, skill or judgment was not limited to telephone directories. Other types of directories were also found to be copyrightable subject matter based upon the "sweat of the brow" standard of originality. *Schroeder v. William Morrow & Co.*, 566 F.2d 3 (7th Cir. 1977) was one such case. *Schroeder* involved a gardening directory entitled "The Green Thumbbook." "The Green Thumbbook" included listings of the names and addresses of suppliers of seeds, plants, publications, and other items useful to gardeners. In the preparation of its own directory, the defendant copied the names and addresses appearing on 27 of 63 pages (approximately 43%) of "The Green Thumbbook." This copied material amounted to approximately one percent of the material in the defendant's directory.

In finding "The Green Thumbbook" to be copyrightable subject matter, the court stated:

An original compilation of names and addresses is copyrightable even though the individual names and addresses are in the public domain and not copyrightable. [Citations to *Leon* and *Jeweler's Circular* omitted.] As the latter case observed, only "industrious collection," not originality in the sense of novelty, is required. . . .

¹¹ The "sweat of the brow" standard of originality is also known by several other equivalent terms, such as "industrious collection," "effort" and "labor."

The copyright protects not the individual names and addresses but the compilation, the product of the compiler's industry. . . .

Defendants are not exonerated by the fact that the compilers of their book copied only the names and addresses and not the accompanying descriptive material that appeared in plaintiff's book. The copyright protected not merely the descriptive material but also "the selection, the ordering and arrangement" of the names and addresses. *Edwards & Deutsch Lithographing Co. v. Boorman*, 15 F.2d 35, 36 (7th Cir.), cert. denied, 273 U.S. 738 (1926). Plaintiff's catalog would have been copyrightable without the descriptive material. The inclusion of that material, which was also copyrightable, did not destroy the protection the law affords the compilation of names and addresses.

Id. at 5-6 (emphasis added).¹² The holding in *Schroeder* was recently approved by this Court which observed that

¹² The language "the selection, the ordering and arrangement" in *Schroeder* was taken from *Edwards & Deutsch Lithographing Co. v. Boorman*, 15 F.2d 35 (7th Cir. 1926), cert. denied, 273 U.S. 738 (1926) which quoted Justice Clifford in *Lawrence v. Dana*, Fed. Cas. No. 8,136 as follows:

Copyright may justly be claimed by an author of a book who has taken existing materials from sources common to all writers, and arranged and combined them in a new form, and given them an application unknown before, for the reason that, in so doing, he has exercised skill and discretion in making these selections, arrangements, and combinations, and, having presented something that is new and useful, he is entitled to the exclusive enjoyment of his improvement, as provided in the copyright act.

Edwards & Deutsch Lithographing Co., 15 F.2d at 36. Justice Clifford's language in *Lawrence v. Dana* may well be the origin of the

the "[c]reation of a nonfiction work, even a compilation of pure fact, entails originality." *Harper & Row, Publishers, Inc. v. Nation Enters.*, 471 U.S. 539, 547 (1985) (emphasis added).

The foregoing only briefly discusses cases deciding the copyrightability of compilations under the 1909 Copyright Act by applying the "sweat of the brow" standard of originality.¹³ The following is a list of additional cases decided under the 1909 Copyright Act applying the "sweat of the brow" standard: *Donald v. Zack Meyer's T.V. Sales and Serv.*, 426 F.2d 1027 (5th Cir. 1970); *Orgel v. Clark Boardman Co.*, 301 F.2d 119 (2d Cir. 1962); *Amsterdam v. Triangle Publications, Inc.*, 93 F. Supp. 79 (E.D. Pa. 1950); *Adventures in Good Eating v. Best Places to Eat*, 131 F.2d 809 (7th Cir. 1942); *Hartfield v. Peterson*, 91 F.2d 998 (2d Cir. 1937); *Southwestern Bell Tel. Co. v. Nationwide Indep. Directory Serv., Inc.*, 371 F. Supp. 900 (W.D. Ark. 1974); *Baldwin Cooke Co. v. Keith Clark, Inc.*, 383 F. Supp. 650 (N.D. Ill. 1974); *Cincinnati & Suburban Tel. Co. v. Brown*, 44 F.2d 631 (S.D. Ohio 1930); *American Travel & Hotel Directory Co. v. Gehring Publishing Co.*, 4 F.2d 415 (S.D.N.Y. 1925); *Jeweler's Circular Publishing Co. v. Keystone Publishing Co.*, 281 F. 83 (2d Cir.), cert.

definition of a compilation in the 1976 Copyright Act. 17 U.S.C. § 101 (1976).

¹³ The "sweat of the brow" standard of originality was not a creature born of the 1909 Copyright Act. The standard was liberally applied by the courts under the prior copyright act. The following cases applying the "sweat of the brow" standard predate the 1909 Copyright Act: *Social Register Ass'n v. Murphy*, 128 F. 116 (D.R.I. 1904); *American Trotting Register Ass'n v. Gocher*, 70 F. 237 (N.D. Ohio 1895); *Brunell v. Chown*, 69 F. 993 (N.D. Ohio 1895); *Hanson v. Jaccard Jewelry Co.*, 32 F. 202 (E.D. Mo. 1887).

denied, 259 U.S. 581 (1922); *American Code Co. v. Bensinger*, 282 F. 829 (2d Cir. 1922).¹⁴

The "sweat of the brow" standard of originality was not only an existing standard for originality of compilations applied by the courts under the 1909 Copyright Act, it was a prominent standard. It was not until after the enactment of the 1976 Copyright Act that the "sweat of the brow" standard began to be questioned by some courts and commentators. As will be shown below, however, the legislative history of the 1976 Copyright Act discloses that no displeasure was expressed with respect to the existing standards of originality under the 1909 Copyright Act. The 1976 Copyright Act was not adopted to resolve any alleged split among the circuits as to the standard of copyrightability of compilations or to correct an improper standard of originality then being applied by the courts. In fact the opposite was true. The "sweat of the brow" standard of originality was alive and well at the time of the drafting of the 1976 Copyright Act and Congress expressly decided to adopt the existing standards of originality as expressed by the courts at that time.

¹⁴ The "sweat of the brow" standard of originality continues to be applied by the courts under the 1976 Copyright Act. Cases decided under the 1976 Copyright Act which based copyrightability on this standard include: *United Tel. Co. v. Johnson Publishing Co.*, 671 F. Supp. 1514 (W.D. Mo. 1987), *aff'd*, 855 F.2d 604 (8th Cir. 1988) [telephone directory]; *Hutchinson Tel. Co. v. Fronteer Directory Co.*, 770 F.2d 128 (8th Cir. 1985) [telephone directory]; *Rand McNally & Co. v. Fleet Management Sys.*, 600 F. Supp. 933 (N.D. Ill. 1984) [mileage table on map]; *National Business Lists, Inc. v. Dun & Bradstreet, Inc.*, 552 F. Supp. 89 (N.D. Ill. 1982) [credit information]; *Northwestern Bell Tel. Co. v. Bedco of Minnesota, Inc.*, 501 F. Supp. 299 (D. Minn. 1980) [telephone directory]; *Northwestern Tel. Sys., Inc. v. Local Publications, Inc.*, 208 U.S.P.Q. 257 (D. Mont. 1979) [telephone directory].

B. The legislative history of the 1976 Copyright Act demonstrates a Congressional intent to incorporate, without change, the standards of originality established by the courts under the 1909 Copyright Act.

The 1976 Copyright Act was the result of numerous proposed draft bills and extensive hearings, debates and discussions extending over three decades. The movement for general revision of the 1909 Copyright Act began as early as 1924. Between 1961 and 1964, many meetings and discussions were held under the auspices of the Copyright Office. As a result, in 1965, the Copyright Office published "The Supplementary Report of the Register of Copyrights on the General Revision of the U.S. Copyright Law: 1965 Revision Bill." From 1964 to 1975, various versions of the copyright bill were considered and amended by both Houses of Congress. In 1975, the House Judiciary Subcommittee conducted extensive hearings at which nearly 100 witnesses testified. In that same year, the Register of Copyrights issued a "Second Supplementary Report on General Revision of the U.S. Copyright Law." In 1976, 22 days of public mark-up sessions were conducted. The final version of the bill was passed by the House on September 30, 1976, by the Senate on September 30, 1976 and was signed by President Ford on October 19, 1976. The new law became effective on January 1, 1978.

1. Copyrightability under the 1976 Copyright Act is found in "original works of authorship." That term was intentionally left undefined so that the standards of copyrightability established by the courts under the 1909 Copyright Act would not be changed.

The portion of the 1976 Copyright Act addressing copyrightability is Section 102, which provides in pertinent part:

Copyright protection subsists, in accordance with this title, in **original works of authorship** fixed in any tangible medium of expression, now known or later developed, from which they can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device. Works of authorship include the following categories:

- (1) literary works

17 U.S.C. § 102(a) (emphasis added).

The legislative history of Section 102 indicates that directories are to be considered copyrightable subject matter as literary works:

The term "literary work" does not connote any criterion of literary merit or qualitative value: it includes catalogs, **directories**, and similar factual, reference, or instructional works and compilations of data. It also includes computer data bases

H.R. Rep. No. 1476, 94th Cong., 2d Sess. 54 (1976) (emphasis added). Furthermore, Section 103 of the 1976 Copyright Act specifically states that compilations, such

as telephone directories, are copyrightable subject matter:

The subject matter of copyright as specified by section 102 includes compilations. . . .

17 U.S.C. § 103(a) (1976). Therefore, Congress undoubtedly intended directories to be copyrightable subject matter under the 1976 Copyright Act.

Section 102 sets forth only two criteria by which copyrightable subject matter, such as a directory, is measured. In order to be copyrightable, a work must be an "original work of authorship" and it must be "fixed in any tangible medium." In the case of telephone directories, the latter requirement is not an issue; a printed telephone directory is unquestionably a tangible medium. The issue is usually whether the white pages portion of the directory constitutes an "original work of authorship."

The legislative history of Section 102 indicates that:

The phrase "original works of authorship" which is purposely left undefined, is intended to **incorporate without change the standard of originality established by the courts under the present copyright statute** [the 1909 Copyright Act]. This standard does not include requirements of novelty, ingenuity, or esthetic merit, and there is no intention to enlarge the standard of copyright protection to require them.

H.R. Rep. No. 1476, 94th Cong., 2d Sess. 51 (1976); S. Rep. No. 473, 94th Cong., 1st Sess. 50 (1975) (emphasis added). Congress made an intentional decision to leave the term "original work of authorship" undefined and to therefore endorse the standards of originality espoused by the courts under the 1909 Copyright Act.

That this action by Congress was intended and not merely an accident or an oversight is further evidenced by the comments of the Register of Copyrights.

The 1963 "Preliminary Draft for Revised U.S. Copyright Law" defined "original" as follows:

A work of authorship is "original" if it is the independent creation of an author who did not copy it from another source.

Patry, *Copyright in Collections of Facts: A Reply*, 6 Comm. & L. 11, 21 (October 1984) (citing Copyright Law Revision Part 3 at 1) (footnote omitted). The 1964 bills, however, dropped the draft bill definition of "original" authorship. This omission was explained by Register Kaminstein in his 1965 Supplementary Report as follows:

The 1961 Report pointed out that "original creative authorship" is a fundamental criterion of copyright protection under the present law, and recommended that this requirement be specified in the statute. However, when it came to drafting, a great deal of concern was expressed about the dangers of using a word like "creative" in this context. It was argued that the word might lead courts to establish a higher standard of copyrightability than that now existing under the decisions, and that any effort to define "original" could bring about the same undesirable result.

In recognition of these arguments, section 102 of the bill specifies the subject matter of copyright simply as "original works of authorship," without further attempts at definition. Our intention here is to maintain the established

standards of originality without implying any further requirements of aesthetic value, novelty, or ingenuity.

Patry, *supra*, 6 Comm & L. at 25 (citing Copyright Law Revision Part 6 at 3) (emphasis added) (footnote omitted).

Therefore, a directory is copyrightable subject matter as an original work of authorship under Section 102 of the 1976 Copyright Act if it satisfies the standards of originality established by the courts under the 1909 Copyright Act. Accordingly, the 1976 Copyright Act endorsed the copyrightability of directories which were created under the "sweat of the brow" and "arrangement" standards.

2. The definition of a "compilation" in the 1976 Copyright Act includes works produced by "sweat of the brow," as well as "arrangement."

The 1976 Copyright Act defines a compilation as follows:

A "compilation" is a work formed by the collection and assembly of preexisting materials or of data that are selected, coordinated, or arranged in such a way that the resulting work as a whole constitutes an original work of authorship.

17 U.S.C. § 101 (1976). Since compilations were intended by Congress to be copyrightable subject matter under both the "sweat of the brow" standard of originality and the "arrangement" standard of originality, the definition of a compilation in Section 101 of the 1976 Copyright Act must encompass both standards of originality. To do

otherwise would be to establish a different or higher standard of copyrightability than existed under the 1909 Copyright Act. Such a result was not intended by Congress. An examination of the legislative history as it applies to the definition of a compilation reveals that the definition does indeed cover compilations created by "sweat of the brow."

The 1963 "Preliminary Draft for Revised U.S. Copyright Law" defined a compilation as follows:

A compilation is a work formed by the collection and assembling of works, parts of works, or material not subject to copyright in a way that, as the result of selection, systematization, coordination, arrangement, or rearrangement, it represents an independent creation.

Patry, *supra*, 6 Comm. & L. at 22 (citing Copyright Law Revision Part 3 at 1-2) (footnote omitted). Although the wording of the definition of a compilation in the 1976 Copyright Act was changed from the definition in the 1963 Preliminary Draft, the Copyright Office, in discussions on the bill, indicated that it:

"had no intention of changing the substantive effect of what we had in the preliminary draft . . . We have rearranged some of the provisions in the preliminary draft but without any intention of changing the meaning."

Patry, *supra*, 6 Comm. & L. at 24 (footnote omitted).

The fundamental difference between the definition of a compilation in the 1963 Preliminary Draft and the 1976 Copyright Act is in the use of the term "independent creation." The term "independent creation" used in the Preliminary Draft was changed to the term "original

work of authorship." The use of the term "original work of authorship" in the definition of a compilation in Section 101 indicates the intent to again leave the standard of copyrightability unchanged; the legislative history indicates that this term was used to avoid the establishment of a different or higher standard of copyrightability than existed under the 1909 Copyright Act.

The definition of a compilation in Section 101 of the 1976 Copyright Act also states that the "resulting work as a whole constitutes an original work of authorship." Although there is no definition of the term "work as a whole" in the 1976 Copyright Act, it should not be construed to change the standard of copyrightability. In light of the previous comments regarding the absence of any intent to make substantive changes from the 1963 Preliminary Draft, it is apparent that the term "work as a whole" has the same meaning as applied to derivative works:

. . . there is no explanation for the inclusion in the definition of "compilation" of the phrase "as a whole," which had previously been found only in the definition of a "derivative work." One can only surmise from the explanation of the phrase's meaning in the derivative work context, and the Register's statement that no substantive change was intended from the 1963 definition, that in determining originality for compilations, e.g., whether the work was independently produced, one looks to the final combination of the "material" as a whole in order to judge whether that combination is original with the compiler. If so, and assuming there are no other bars to protection (e.g., *de minimis* amount, merger of

idea and expression), the compilation is protectible.

Patry, *supra*, 6 Comm. & L. at 24. The language "work as a whole constitutes an original work of authorship" therefore means that one looks to the final combination of material as a whole in order to judge whether that combination is an original work of authorship. Those words do not change the standard of originality as required by Section 102. Furthermore, the legislative history of the 1976 Copyright Act makes it abundantly clear that the intention of Congress in adopting the Act was to maintain the established standards of originality existing under the 1909 Act. Since "sweat of the brow" was an established standard of originality under the 1909 Copyright Act, "sweat of the brow" should be included within the definition of a compilation as it appears in Section 101 of the Act. To do otherwise would be counter to the intent of the legislature.

Where Congress has enacted a clear and comprehensive statute pursuant to a broad constitutional grant of power, as it has here, it is not for the courts to undermine legislative intent by carving out exceptions that Congress did not choose to make.

Hutchinson Tel. Co. v. Frontier Directory Co., 770 F.2d 128, 132 (8th Cir. 1985).

The proper interpretation to be given to the Section 101 definition of a compilation encompasses both the "sweat of the brow" standard of originality and the "arrangement" standard of originality. Such a construction is consistent with the clear legislative intent in enacting that statute. Furthermore, such an interpretation is in accord with the multitude of decisions finding

compilations created by "sweat of the brow," as well as "arrangement," to be protectable.

C. The scope of copyright protection for compilations is determined by whether the copyrightable expression was copied, not by the standard of originality.

Having established that "sweat of the brow" is an appropriate standard for originality, how does it affect the scope of copyright protection in this case? The answer is that it does not affect the scope directly, but, rather, indirectly. The scope of copyright protection is the same whether one applies the "sweat of the brow" standard of originality or the "arrangement" standard of originality. The scope of copyright protection for a compilation is determined by whether the copyrightable expression was copied.¹⁵ *United Tel. Co. v. Johnson Publishing Co.*, 855 F.2d 604, 606 (8th Cir. 1988).

1. The copyrightable expression of a compilation found to be copyrightable under the "sweat of the brow" standard is the selection of the preexisting material contained in the compilation.

The expression "sweat of the brow" has been used to articulate the copyrightable expression of a compilation when its "originality" is in the particular selection of preexisting materials which made up the compilation rather than the format or arrangement of that material. In reality, "sweat of the brow" is merely another way of stating that a work was independently created. The concept of independent creation is inherent in the concept of

¹⁵ The alleged split in the Circuits as to the standard of copyrightability which formed the basis for the grant of certiorari in the present case has no effect upon the scope of copyright protection.

expending labor, skill or effort to collect and assemble material from numerous sources and select, coordinate or arrange that material into a new work. The 1976 Copyright Act defines a compilation as follows:

A "compilation" is a work formed by the collection and assembly of preexisting materials or of data that are selected, coordinated, or arranged in such a way that the resulting work as a whole constitutes an original work of authorship.

17 U.S.C. § 101 (1976). The requirement that the preexisting material be "selected, coordinated or arranged" is stated in the disjunctive. Therefore, the presence of any one of those elements satisfies the definition of a compilation. Applying the definition of "the resulting work as a whole" discussed in Section B.2. above, the definition of a compilation could be written as follows: A "compilation" is a work formed by the collection and assembly of preexisting material . . . that are selected . . . in such a way that the [final combination of the material, as a whole, is original with the compiler]. See Patry, *supra*, 6 Com. & L. at 24.

This definition of a compilation perfectly describes a compilation which is copyrightable under the "sweat of the brow" standard.

2. Judicial decisions support the interpretation of the Section 101 definition of a compilation as including the "sweat of the brow" standard of originality.

As discussed above, *Leon v. Pacific Tel. & Tel. Co.*, 91 F.2d 484 (9th Cir. 1937) involved a conventional white page telephone directory published by Pacific Telephone containing listings arranged in alphabetical order. The

defendant copied the listings from Pacific Telephone's directory but the defendant rearranged those listings into street name order. The Pacific Telephone directory was found to be copyrightable based on "sweat of the brow." The effort in collecting the names, addresses and telephone numbers from the multitude of telephone subscribers resulted in an original selection of information. That is, the individual names, addresses and telephone numbers were preexisting information. However, the group of listings which Pacific Telephone gathered together, when considered as a whole, was original in that it was independently created i.e., it was not copied from another source. The copyrightable expression in the Pacific Telephone directory was therefore at least the original selection of listings contained in the directory. See *List Pub. Co. v. Keller*, 30 F. 772, 773 (C.C.S.D.N.Y. 1887) ("They [names and addresses] are original to the extent that the selection is original.").

By copying all of the listings in the Pacific Telephone directory, the defendant in *Leon* copied the copyrightable selection of listings from the Pacific Telephone directory. Therefore, the fact that the defendant rearranged those listings was irrelevant since the same selection of listings was included in the defendant's directory. The defendant was properly found to have infringed the copyright of Pacific Telephone because the defendant's directory was a substantial copy of the copyrightable expression from the copyrighted directory.

This same type of analysis can be made of *Schroeder v. William Morrow & Co.*, 566 F.2d 3 (7th Cir. 1977). As stated above, the copyrighted work in *Schroeder*, "The Green Thumbbook," included listings of the names and addresses of gardening suppliers. The defendant's copying of approximately one-third of the names and ad-

dresses from "The Green Thumbbook" without copying the arrangement of those names and addresses constituted copyright infringement because the defendant made a substantial copy of the same selection of names and addresses from the copyrighted directory.¹⁶

3. Protecting the selection of preexisting material contained in a compilation prepared by "sweat of the brow" is in accordance with the policies underlying the Copyright Law.

Protecting the copyrightable selection of names and addresses in a directory does not frustrate either the provisions of Section 103 of the 1976 Copyright Act or the constitutional basis for copyright protection. Section 103(b) provides, in pertinent part, that:

The copyright in a compilation or derivative work extends only to the material contributed by the author of such work, as distinguished from the preexisting material employed in the work, and does not imply any exclusive right in the material.

17 U.S.C. § 103(b) (1976).

In the case of a compilation which is original under the "sweat of the brow" standard of originality, the

¹⁶ A similar analysis can be made of the following cases: *Hutchinson Tel. Co. v. Frontier Directory Co.*, 770 F.2d 128 (8th Cir. 1985); *Eckes v. Card Prices Update*, 736 F.2d 859 (2d Cir. 1984); *United Tel. Co. v. Johnson Publishing Co.*, 671 F. Supp. 1514 (W.D. Mo. 1987), *aff'd*, 885 F.2d 604 (8th Cir. 1988); *National Business Lists v. Dun & Bradstreet, Inc.*, 552 F. Supp. 89 (N.D. Ill. 1982); *Northwestern Bell Tel. Co. v. Bedco of Minnesota, Inc.*, 501 F. Supp. 299 (D. Minn. 1980); *Northwestern Tel. Sys. v. Local Publications*, 208 U.S.P.Q. 257 (D. Mont. 1979); *Southwestern Bell Tel. Co. v. Nationwide Indep. Directory Serv., Inc.* 371 F. Supp. 900 (W.D. Ark. 1974); *List Pub. Co. v. Keller*, 30 F. 772 (C.C.S.D.N.Y. 1887).

selection of the preexisting material which makes up the compilation is the "material contributed by the author." Anyone is free to copy the preexisting material from a directory. What cannot be done is to make a substantial copy of the selection of preexisting materials in a directory because the selection of that material is what is contributed by the author; copyright in a compilation extends to the selection of preexisting materials.

Applying this principle to a telephone directory prepared by "sweat of the brow," the selection of listings contained in the directory is the material contributed by the author.¹⁷ Therefore, copyright protection extends to that selection of listings in the directory. In accordance with the provisions of Section 103(b), one can copy an insubstantial number of the listings contained in the directory. Conversely, one cannot copy every listing in a telephone directory because that is clearly a copying of the original selection of preexisting material from the directory, i.e., the material contributed by the author. It is also clear that it is not necessary to copy the entire selection of listings to infringe the copyright in the directory; a substantial copying of the material contributed by the author constitutes copyright infringement. *Toksvig v. Bruce Pub. Co.*, 181 F.2d 664, 666 (7th Cir. 1950). Where the line is drawn between the making of a substantial copy of a copyrightable compilation and the copying of preexisting materials should be determined by the facts and circumstances of each case.

¹⁷ A telephone directory may also include other elements of copyrightable expression, such as original coordination and/or arrangement of the preexisting material. However, at a minimum, a telephone directory prepared by "sweat of the brow" will possess an original selection of listings.

This degree of protection does not frustrate the constitutional premise of copyright protection. The progress of science and the useful arts is promoted by permitting preexisting material to be copied from the compilation while the interests of the author are protected by prohibiting the substantial copying of the copyrightable expression of the compilation, i.e., the material contributed by the author.

Telephone directories are obviously made to be used. For the most part, they are distributed to telephone service subscribers free of charge. It is the intent of the telephone company that the directories be used to locate the telephone numbers of individuals or businesses so that use of the telephone system will be facilitated. Certainly, one can write down a name, address and telephone number without infringing the copyright in the directory; one can even write down several listings. This type of copying is either *de minimus* or fair use because it is expected by the publisher and it is not the type which adversely effects the ownership rights of the copyright owner. It is the copier, who methodically reproduces substantial portions of the compilation of listings, who violates the Copyright Law. One who copies substantial amounts from a compilation is likely to be performing the copying for commercial, profit making purposes, rather than for the advancement of the useful arts and sciences.

Protection of the property of an author from unauthorized commercial exploitation is the primary function of the Copyright Law. As this Court has made clear "[t]he rights conferred by copyright are designed to assure contributors to the store of knowledge a fair return for their labor" *Harper & Row, Publishers, Inc. v. Nation Enters.*, 471 U.S. 539, 546 (1985). The value of a compilation often lies only in the selection of the preexist-

ing materials compiled therein. By definition, the constituent elements are preexisting; in the case of many directories, the constituent elements are in the public domain. Therefore, the only protectable rights that a compiler may possess are frequently founded on the particular selection of the preexisting materials which the compiler has chosen to include in the compilation. It is frequently that selection of material, however, which makes the compilation valuable. To permit a copier to take the substance of a compilation without authorization would frustrate the basic premise of Copyright Law as announced by this Court.

CONCLUSION

It is clear that the legislative intent in enacting the 1976 Copyright Act was to preserve the "sweat of the brow" standard of originality, as well as the "arrangement" standard of originality. Original works which are created by the selection of preexisting material or data from numerous sources are valuable because of the collecting, assembling and selecting of that material for publication in a compilation. Such a compilation must be provided a meaningful degree of protection, lest the incentive to create compilations will be destroyed. The result argued by Feist would not provide any meaningful protection for compilations and is contrary to many decades of decisions and the clear intent of Congress when it enacted the 1976 Act to incorporate the then existing standards of originality.

Respectfully submitted,

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